REMARKS

This arequest for reconsideration is in response to the Office Action of January 23, 2008 in which claims 1, 4, 11, 29, 32, 39, 58 and 61 were rejected.

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Furthermore, claims 1, 11, 29 and 39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22 and 32 of US Patent No 6717931.

This double patenting rejection is removed by a terminal disclaimer submitted herein.

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Claims 1, 29, 58 and 61 are rejected under 35 U.S.C. 103(a) as being anticipated by Fiorini et al (US Patent No. 6760596) in view of Bourlas et al (US Patent 7023798).

The applicant disagrees with these rejections and refers to the arguments present in the Remarks Section of the Amendment A submitted on September 10, 2007 and in the Remarks Section of the Amendment B submitted on December 20, 2007. Some arguments are repeated and additional arguments are presented below.

The Examiner practically modified the rejection of the previous office action by adding the reference of Bourlas et al disclosing determining a frame or a block error rate of the radio uplink channel. It is not clear to the applicant why this reference of Bourlas et al is relevant because measuring SNR of a channel is well known in the art.

First, the Examiner admits that Fiorini et al failed to disclose determining a frame or block error rate of the radio uplink channel, but Bourlas et al did. Then the question is how Fiorini et al can possibly disclose "changing a spreading factor used for uplink channel spreading to counteract said fluctuation in order to keep the predetermined parameter related to said fluctuation substantially near a threshold value by increasing or

decreasing said spreading factor, wherein said changing the spreading factor is **carried out only if said frame or said block error rate meets a selected criterion**.", as recited, e.g., in claim 1 of the present invention. In other words, if Fiorini et al do **not measure or determine** a frame or block error rate of the radio uplink channel, as admitted by the Examiner, how then Fiorini et al can use this "**non-determined" or un-known** frame or block error rate by changing the spreading factor only "**if said frame or said block error rate meets a selected criterion"**, as recited in claim 1 of the present invention. Therefore Fiorini et al do not disclose this limitation of claims 1 and 29.

Moreover, as was pointed out in the Amendment B submitted on December 20, 2007, Fiorini et al not only do not disclose the step of "**further determining a frame or block error rate of said radio uplink channel**", as recited in claim 1 (the same is applied to claim 29), but do not disclose a **dependence** of the spreading factor on **two** parameters: a **predetermined parameter such as C/R ratio** and the **frame or block error rate** (as recited in claims 1 and 29 of the present invention), which is different from what is taught by Fiorini et al. describing a **dependence** only on **one parameter**, e.g., C/R ratio, but not on both.

Furthermore, as discussed herein, measuring SNR of a channel is known in the art, e.g., from Bourlas et al as alleged by the Examiner. Then the question is not that SNR measurement can be made in a channel in principle **but why** in a particular situation disclosed in claim 1 and 29 of the present invention. The Examiner alleged in the Office Action that measuring BER (e.g., per Bourlas et al) would be beneficial for "improving uplink quality". The applicant contends that measuring BER is an expensive procedure, and without a clear goal in mind (as recited in claims 1 and 29 of the present invention), this BER measurement would not make any sense.

In other words, the Examiner's reasoning (e.g., "improving

uplink quality" for for incorporating Bourlas et al. into Fiorini et al. to arrive at the subject matter of claims 1 and 29 is practically similar to "shared advantage" approach such as achieving competitive advantage or economical advantage (which can make any invention obvious) irrelevant to the "problem to be solved" by the present invention, e.g., **adapting spreading factor** based on the power control facilitated by the power control command".

The Manual of Patent Examining Procedure (the MPEP) clearly refers to the "problem to be solved" approach and cites a relatively recent Federal Circuit case supporting its use: "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee,* 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones,* 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). MPEP 2143.01.

Furthermore, the Office practically ignores MPEP Paragraph 2143 which requires to provide a proof of suggestion or motivation for combining reference, because any patent issued in the past and in the future can be declared invalid by combining in hindsight separate parts of any invention known from different sources. The burden of proof is on the Patent Office to provide the evidence, which is not done here.

Thus, claims 1 and 29 of the present invention are novel and not obvious over Fiorini et al under 35 U.S.C. 103(a) in view of Bourlas et al. Moreover, the novelty of claims 58 and 61 is

provided by the novelty and non-obviousness of claims 1 and 29 under 35 U.S.C. 103(a) as being anticipated by Fiorini et al over Bourlas et al.

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Claims 4, 11, 32 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over under 35 U.S.C. 102(e) as being anticipated by Fiorini et al. (US Patent No. 6760596) in view of Bourlas et al (US Patent 7023798) and further in view of Sadri et al (U.S. Patent No.: 6,690,652).

The novelty of dependent claims 4, 11, 32 and 39 is provided by the novelty and non-obviousness of independent claims 1 and 29 under 35 U.S.C. 103(a), as shown herein. Also more arguments can be made in regard to motivation to combine references and problem to be solved to rebut this rejection.

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The rejections of the Official Action of January 23, 2008, having been obviated by this amendment or shown to be inapplicable, withdrawal thereof is requested, and passage of the claims to issue is solicited.

Respectfully submitted,

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